

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/765,834

Applicant(s)

NOBUTO ET AL.

Examiner

JENNIFER STEELE

Art Unit

1794

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-7

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

J. S./
Examiner, Art Unit 1794

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

Continuation of 11, does NOT place the application in condition for allowance because: Applicant did not amend claims and Applicants arguments After Final are OK to Enter. Applicants arguments are not persuasive and the previous 35 USC 112 1st paragraph rejection and the 35 USC 102(e) rejection over US 6,767,853 and the 35 USC 102(b) and 35 USC 103(a) rejections over EP 1067234 are maintained. Response to Applicants arguments that follows pertains to all rejections being maintained.

Applicant disagrees with the Examiner's alleged lack of basis in the specification for the negative limitation in Claim 1 and states that the "lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support". Examiner notes that Applicant's arguments are clear and explain how the microfibrillar fiber bundle (A) is produced from Spinning Example 1 and microfibrillar fiber bundle (B) is produced from Spinning Example 5 and that Example 1 is formed by blending, the microfibrillar fiber forming fibers obtained in Spinning Examples 1 and 2 and finally made into the leather-like sheet substrate. Applicant's arguments are not persuasive because the specification must be relied upon for this clear and concise disclosure. As written in the previous 35 USC 112 1st rejection, the specification is written to state that Spinning Example 1 is formed from polyurethane as the island component and polyethylene as the sea component are spun into a microfibrillar fiber-forming fiber. Spinning Example 1 does not equate this microfibrillar fiber-forming fiber to the microfibrillar fiber bundle (A) as recited in Claim 1. Spinning Example 1 is made from polyurethane which the specification does teach is elastic. Claim 1 also describes "the microfibrillar fiber bundle (A) comprising 10 to 100 microfibrillar fibers ...which are made of an elastic polymer" Comprising is not exclusive of other types of fibers and therefore applicant's arguments not commensurate with the scope of the claims. As the limitation is written "wherein microfibrillar fiber bundle (A) does not include non-elastic polymers and microfibrillar fiber bundle (B) does not include elastic polymer", the specification is not clear that spinning example 1 is microfibrillar fiber bundle (A) and therefore the embodiment of Example 1. Applicant's arguments that the disclosure can be implicit are not persuasive. The specification does not describe the invention as claimed in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

As Applicants are claiming that the bundles of (A) comprise 10 to 100 microfibrillar fibers and the term comprise is not exclusive, Applicants arguments that Nakayama does not disclose fiber bundles with only elastic fibers are not persuasive. .